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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/415,986      | 10/12/1999  | DAVID H. SITRICK     | STD-1748            | 5549             |

20787 7590 10/04/2002

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EXAMINER

SAGER, MARK ALAN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3714

DATE MAILED: 10/04/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/415,986

Applicant(s)  
Sitrick

Examiner  
Sager

Art Unit  
3714



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Sep 20, 2001, Oct 23, 2001 and Feb 25, 2002

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 25-43 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 25-43 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

MARK SAGER  
PRIMARY EXAMINER

## Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6) ☐ Other:

*Restriction/Election of Species*

1. Applicant's election of Species IV (clms 25-43) in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

*Specification*

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: skewing or rotating (clms 30, 34, 39, 43), morphing or film grain, or tinting or adjusting hue (clms 32, 34, 41, 43), Mercatur projection or geometric model or geometric mesh or morphing coordinate points or geometric constraint information or colorimetry information (clms 33-34, 42-43).

*Double Patenting*

3. Claims 25-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of U.S. Patent No. 5,553,864. Although the conflicting claims are not identical, they are not patentably distinct from each other because: Sitrick claims a means for providing a predefined source which is known as presentation output of the audiovisual presentation. Additionally, although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to claim the method or system [device/apparatus] broader in order to obtain the most commercially viable form of invention or in order to obtain the broadest protection for invention for securing

commercial viability. Essentially, the omitted language pertaining to the 'analyzing the presentation output associated with the selected portion' limited the invention and thus by omitting the language, a broader form of invention is claimed which secures broader protection for commercial viability.

### *Claim Objections*

4. Claims 25-34 are objected to because of the following informalities: claim appears to contain missing language due to phrase 'at least of and' (line 5). Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

5. Claims 25-28, 33-37 and 42-43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bloch et al (4688105).

6. Claims 25-27, 33-36 and 42-43 are rejected under 35 U.S.C. 102(a) as being anticipated by applicants background of admitted prior art. Background of specification discloses incorporation of audience members into old video clips teaching (3:12-24) claimed invention, as broadly claimed.

### *Claim Rejections - 35 USC § 103*

7. Claims 29-32 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloch et al (4688105). Bloch discloses a video recording system for a user to 'interact' with a prerecorded video sequence of any sort while the interaction is itself being recorded (2:42-68) such that the user may appear in certain scenes and not appear in others (2:3-29) disclosing claimed invention, as broadly claimed, except 'transforming... content' (clms 29 and 38), 'scaling,

... filtering' (clms 30 and 39), 'graphical modification... content' (clms 31 and 40), 'morphing... color-correction' (clms 32 and 41). Scaling or filtering an image and color correction of an image such as by tinting or by adjusting hue are extremely well known techniques in image processing for film, movie, advertising and video for transforming image content or graphical modification of the image content so as to improve the blending of an image into the presentation. Therefore, it would have been obvious to an artisan at the time the invention was made to add transforming the user image content, scaling or filtering, graphical modification of user image content and tinting or adjusting hue or color-correction as well known image processing techniques to Bloch's recording system so as to improve the blending of the image into a presentation.

*Response to Arguments*

8. Applicant's arguments filed Sep 14, 2001 have been fully considered but they are not persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Such as demonstrated by Applicant's response on page 10 that 'pending claims 35-44 are patentably distinguishable and patentable over all art of record, alone or in combination' equates to a general assertion of patentability for claimed invention, as amended. Such sweeping assertion is not persuasive. Additionally, the amended language pertains to content of source which is germane to content of existing films (i.e. movies) or interactive games which therefore, Applicant is asserting patentability on content of an audiovisual source which is germane to a source as conventional. Restated, existing movies contain many actors (plurality of characters) and interactive games

contain either plurality of story-lines, such as by branching, or plurality of characters, such as hero and villain and thus, Applicant is asserting patentability on conventional aspects.

Regarding particular amended language, it is conventional for movies or films to possess a plurality of characters while it is conventional for video games to possess either a plurality of characters or a plurality of story lines (e.g. branching). Bloch discloses a video recording system for a user to 'interact' with a prerecorded video sequence of any sort including selected scenes of an interactive video game or existing film or video recording for interaction with characters therein (2:43-66, 10:33-40) such that the user may appear in certain scenes and not appear in others (2:3-29, 10:33-40, 4:58-63, 8:44-63) by multiple users (11:12-15) teaching claimed invention including providing user data (figs. 1-15), providing a predefined source comprising 'at least one of a plurality of story-lines and a plurality of characters' (10:33-40), selecting a portion of a/v program content (2:3-29 and 42-66, 10:33-40, 4:58-63, 8:44-63), integrating user data with selected portion of a/v content (2:3-29, 10:33-40, 4:58-63, 8:44-63), providing a modified output... responsive to selected portion (1:45-2:66, 3:41-53, 10:33-40, 4:58-63, 5:29-36, 8:44-63, fig. 3, ref. 37) such as by using either chromakeyer (41) or digital video effects such as Ultimatte (8:44-63) in conjunction with a microcomputer (figs. 1-15, ref. 45) such that claimed steps of method or system fails to preclude Bloch's recording system. Further, Applicant's invention includes use of Ultimatte (38:15-26). Thus, not only steps of process is taught by Bloch, but also the structure is, in use of Ultimatte as means, the same by means plus functional language incorporation of such known technology.

Finally, it is noted that the Applicant failed to seasonably traverse examiner's well known statements in their response, therefore, the object of the examiner's statements (e.g. scaling or filtering an image and color correction of an image such as by tinting or by adjusting hue are extremely well known techniques in image processing for film, movie, advertising and video for transforming image content or graphical modification of the image content so as to improve the blending of an image into the presentation ) is taken as admitted prior art. *In re Chevenard*, 139 F.2d 711, 60 USPQ 239 (CCPA 1943).

#### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Tom Hughes, can be reached on (703) 308-1806. The fax phone number for this Group is (703) 872-9302. Any inquiry of a general nature or

Application Number: 09/415986  
Art Unit: 3714

Paper No. 13  
Page No. 7

relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to be 'M. Sager', with a stylized, cursive script.

M. Sager  
Primary Examiner  
Oct. 1, 2002